

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

With regard to the restriction requirement, an international or a national stage application is considered to have unity of invention where there exists a “special technical feature” that defines a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. See PCT Rule 13.2.

PCT 13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

See Annex B, Part 2 of the PCT Administration Instructions

MPEP 1850 states *Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims and (i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect to any claims that depend on the independent claims; (ii) If however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on the claim need to be carefully considered. If there is no link remaining an objection of lack of unity a posteriori (that is, arising only after assessment of the prior art) may be raised. See ANNEX B: Unity of Invention Part 1 “Instructions Concerning Unity of Invention” MPEP AI-6 (Rev. 1. Feb. 2003). (Emphasis added)*

Accordingly, since claim 1 is the only independent claim in the application, and since the Examiner has not cited any prior art against claim 1, no problem of lack of unity of invention arises in respect to any of the claims that depend on claim 1.

In response to the objection to the specification for lack of clarity, formulae (IIa) on page 8, (II) on page 10 and (IIa) on page 11 have been replaced by the corresponding formulae on pages 27 and 29, which include the missing substituents. This renders the objection to the specification moot.

The rejection of claims 1-2 and 8 under the second paragraph of 35 U.S.C. §112 is respectfully traversed.


In response to this rejection, the expression "if necessary" has been replaced by --optionally--, which is more in accordance with U.S. practice. Furthermore, it is apparent from the specification that the language following "if necessary" in the claims represents preferred embodiments, for example, as indicated by the sentence beginning "Carboxamides are advantageously lactonized in the presence of inorganic or organic acids . . ." at page 8, lines 7-10 of the specification.

In view of the amendments to claims 1, 2 and 8, the objection to claims 2-7 and 9 has also been rendered moot.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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